

REMARKS

Amendments to Specification

In the specification, the paragraph beginning on page 2, line 2, has been amended to indicate that the parent application of this continuation in part application has issued as U.S. Patent 6,250,663. The paragraphs beginning on page 6, line 19, and page 10, line 4, and the Abstract of the Invention have been amended to correct minor editorial problems.

Amendments to Claims

Claims 1-4 remain in this application. Claims 2 and 4 have been amended to overcome the claim rejection under 35 U.S.C. §112 second paragraph.

Amendments to Drawings

No amendments to the drawings were necessary because they correctly correspond to the specification and the claims once claims 2 and 4 were amended.

Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected Applicant's claims under 35 U.S.C. §103(a).

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. §103(a).

The Examiner rejected claims 1-4 under 35 U.S.C. § 103(a) as obvious over U.S. Pat. No. 3,784,219 issued to van der Burgt et al. ("van der Burgt '219"). The Examiner claimed that the teachings of van der Burgt '219 would have motivated one skilled in the art to combine Figures 1 and 2 of van der Burgt '219 to provide the rear frame in Figure 2 of van der Burgt '219 with the fifth wheel in Figure 1 of van der Burgt '219, in order to couple the trailer to the rear frame. The Applicant respectfully disagrees with Examiner's position.

Amendments to the Drawings:

The drawings were objected to under 37 CFR 1.83(a) for not showing every feature of the invention specified in the claims (specifically, claims 2 and 4). However, the claims have been amended to correctly correspond to the specification and the drawings. Therefore, no amendment to the drawings is necessary since claims 2 and 4 were amended.

I. THE EXAMINER FAILED TO MAKE OUT A PRIMA FACIE CASE OF OBVIOUSNESS TO SUPPORT A REJECTION UNDER 35 U.S.C. §103 OF ANY OF APPLICANT'S CLAIMS

The Examiner has failed to establish a prima facie case of obviousness. When examining a patent application, the Examiner has the initial burden of factually supporting a prima facie conclusion of obviousness. *Legal Concepts of Prima Facie Obviousness* MPEP 2142. If the Examiner fails to put forth a prima facie case of obviousness, Applicant has no obligation to come forward with evidence of non-obviousness. *Id.* For the Examiner to establish a prima facie case of obviousness, three criteria must be met. *Establishing a Prima Facie Case of Obviousness*, MPEP 2142. First, there must be a suggestion or motivation to modify or combine the prior art references. *Id.* Second, there must be a reasonable expectation of success. *Id.* Third, the prior art reference must teach or suggest all the claim limitations. *Id.* The Applicant respectfully asserts that the Examiner has failed to meet its evidentiary burden.

1. *The Examiner did not cite any suggestion, teaching, or motivation to select and combine Figures 1 and 2 of van der Burgt '219 to yield Applicant's claimed invention.*

Case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). *See also*, *C.R. Bard, Inc. v M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) (stating “the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Frisch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fire*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1998) (evidence of teaching

or suggestion “essential” to avoid hindsight); *Ashland Oil, Inc. v Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 U.S.P.Q. 657, 667 (Fed. Cir. 1985) (district court’s conclusion of obviousness was error when it “did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination”). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. See, *Interconnect Planning Corp. v Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”). The evidence of a suggestion, teaching, or motivation to combine the references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem to be solved, yet, the range of sources does not diminish the requirement for actual evidence. *In re Denbiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Claim 1

The Examiner did not satisfy the evidentiary requirements to prove that van der Burgt ‘219 suggests a *motivation to combine* Figures 1 and 2 of van der Burgt ‘219 to disclose or suggest Applicant’s claim 1. Rather, the Examiner merely stated that it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the rear frame in Figure 2 of van der Burgt ‘219 with the fifth wheel in Figure 1 of van der Burgt ‘219, in order to couple the trailer to the rear frame. The Examiner’s conclusion necessarily relied not on an individual with ordinary skill in the art, but on an individual with 20/20 hindsight, and Applicant’s disclosure as a blueprint for a solution.

The problem faced by the inventor was how to create a split-frame structure for heavy trucks designed to reduce the transmission of road vibrations from the trailer to the truck cab. Associated with this problem are additional issues related to why the prior art was deficient to solve the problem. One example of an associated problem was how to create a split-frame system for a motor vehicle transporting a trailer that minimized the transmission of the trailer’s vertical and rotational vibrations to the truck cab and included a fifth wheel.

The Examiner never considered this problem, particularly because the Examiner had the benefit of the Applicant's disclosure, which enabled him to see past this additional problem and focus on the solution. In other words, the Examiner solved the problem of "how to create a *split-frame system for a motor vehicle transporting a trailer that included a fifth wheel*" not, "how to create a split-frame system for a motor vehicle transporting a trailer that minimized the transmission of the trailer's vertical and rotational vibrations to the truck cab and includes a fifth wheel."

Van der Burgt '219 may suggest a trailer that lessens road vibrations, but not a split-frame system for a motor vehicle transporting a trailer that minimizes the transmission of the trailer's vertical and rotational vibrations to the truck cab that includes a fifth wheel and a hydraulic system that dampens the vibrations and oscillations within the split-frame system. In fact, the Examiner never indicated that van der Burgt '219 suggested a split-frame system for trailers that included a hydraulic dampening device. In addition, the Applicant's invention describes an interconnecting frame that attaches the front frame and the rear frame. The Examiner relied on the Applicant's disclosure for the solution to the problem, and given the solution proposed by the Applicant's disclosure, Figures 1 and 2 of van der Burgt '219 were an easy selection for combination. The Examiner's analysis improperly relied on Applicant's disclosure as a blueprint for solving the problem. Therefore, the prior art does not render Applicant's invention obvious.

Claims 2-4

The Examiner did not satisfy the evidentiary requirements to prove that Figure 2 of van der Burgt '219 as applied to claims 2-4 suggests a *motivation to combine teachings* to disclose or suggest Applicant's claims. Rather, the Examiner merely implied that Figure 2 of van der Burgt '219 includes all elements of claims 2-4. The Examiner did not even state which prior art was combinable to render Applicant's invention obvious.

Because the Examiner failed to explain why an ordinarily skilled person when faced with the problem solved by Applicant's invention, would 1) reason that the prior art was somehow deficient to solve that problem; and 2) be motivated to select the cited references and combine them, it follows that the Examiner's rejection fails to meet *prima facie*

requirements for an obvious rejection under 35 U.S.C. §103. *See also, In re Rouffet*, 149 F.3d 1350, 1359, 147 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998) (holding that an examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with *no knowledge of the claimed invention*, would have been motivated to select the references, and select the relevant elements from the references for combination in the manner claimed) (emphasis added).

2. *There is no reasonable expectation of success that the devices in Figures 1 and 2 of the van der Burgt '219 reference can be modified to yield the Applicant's invention without destroying the principle of operation of either of the van der Burgt '219 devices.*

A conclusion of obviousness can be maintained by showing a reasonable expectation of success. *In re Rinehart*, 531 F.2d 1048, 1054 (CCPA 1976). However, “[i]f a proposed modification or combination of the prior art would change the operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obvious.” *See, The Proposed Modification Cannot Change the principle of Operation of a Reference*, MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). In the present case, there is no reasonable expectation of success when modifying or combining the devices of Figures 1 and 2 of van der Burgt '219 that does not also destroy the principle of operation of either of the van der Burgt '219 devices.

If Figures 1 and 2 of van der Burgt '219 were combined there would be only one type of trailer that could be hauled on the load frame (11) (i.e. either a semi-trailer or a loading-carrying box) because each embodiment is specifically designed for the type of trailer being hauled. In Figure 1, the load frame (11) has a fifth wheel (12) and is not directly attached to the cabin frame (2). In contrast, the embodiment in Figure 2 includes a load frame (11) that is directly attached to the cabin frame (2) and is designed for securing a loading-carrying box. Combining the two van der Burgt '219 embodiments would destroy either the semi-trailer attachment load frame (11) or the loading-carrying box load frame (11). Thus, there is no evidence of obviousness.

3. *The van der Burgt '219 reference is non-analogous prior art to Applicant's present invention.*

When analyzing the obviousness of the subject matter at issue, the prior art references must be analogous. See, MPEP 2141.01(a). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Moreover, the similarities and differences in the structure and function of the inventions are important in determining the non-analogy or analogy of the references. See, *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). In the present case, the structure and function of van der Burgt '219 is not similar to the present invention.

The suspension system disclosed in van der Burgt '219 is structurally different from Applicant's invention. In van der Burgt '219, the suspension system for road transport vehicles is created from two separate units. (van der Burgt '219, Column 2, lines 28-30). One unit supports the driver, and the other unit supports the load. (van der Burgt '219, Column 2, lines 30-33). More importantly, each unit is *separately connected to the wheels and axels via its own suspension system* (i.e. springs). (van der Burgt '219, Column 2, lines 33-35). In other words, the dampening system on van der Burgt '219 consists of springs that are attached to the wheels and axles that support the load frame and cabin frame independently. Further, in Figure 1 of van der Burgt '219, the load frame and the cabin frame are not even attached; and in Figure 2 of van der Burgt '219, one spring attaches the load frame and the cabin frame.

In contrast, Applicant's invention has a dampening system that attaches directly to the front and rear frames. Here, the split-frame system can consist of two or three frames. When two frames are used in the embodiment, the split-frame system consists of a front frame and a rear frame. The three frame embodiment consists of a front frame, a rear frame, and an interconnecting frame that rigidly secures the front and rear frame together. Moreover, the dampening system in Applicant's invention includes a hydraulic system

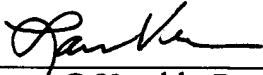
comprised of two hydraulic cylinders mounted to the split-frame system through the use of ball joints. The ball joints are connected to the front and rear frames. These important and essential structural differences render van der Burgt '219 a non-analogous prior art reference.

Conclusion

Applicant respectfully requests that the above amendments be incorporated into the application. Additionally, Applicant believes he has addressed and responded to every point raised in the Examiner's present action. For the reasons stated above, Applicant respectfully requests reconsideration of his application.

Respectfully submitted,

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